

AT



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,584	06/29/2001	Robert S. DeWitte	426.97.265	3885
23483	7590	04/28/2004	EXAMINER	
HALE AND DORR, LLP 60 STATE STREET BOSTON, MA 02109			LY, CHEYNE D	
			ART UNIT	PAPER NUMBER
			1631	

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/897,584

Applicant(s)

DEWITTE ET AL.

Examiner

Cheyne D Ly

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on April 09, 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): 35 U.S.C. 112, First Paragraph, lack of enablement rejection.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) Arguments HAVE BEEN Fully Considered a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-4.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's arguments directed to the 35 U.S.C. 102 and 103 prior art rejections have been fully considered and found to be unpersuasive as discussed below. Therefore, said arguments are not deemed to place the application in condition for allowance.

Continuation of 10. Other:

Claims 1, 3, and 4 are rejected under 35 U.S.C. 102(b) as being clearly by anticipated by DeLisi et al. (US 5,495,423 A). This rejection is maintained with respect to claims 1, 3, and 4 as recited in the previous office action mailed May 12, 2003.

RESPONSE TO ARGUMENT

Applicant's argument of DeLisi et al. does not teach or suggest the use of the second-generation molecules as set forth in the claims has been fully considered and found to be unpersuasive. The method of DeLisi et al. comprises retrieving previously established low-energy amino acid (highest ranking), selecting a ligand anchor pair from among the low-energy amino acid configurations (second-generation molecules) (column 3, lines 8-13). "For example, the ring of Phe-5, placed high out of the binding groove by the CONGEN search in the lowest energy structures,...CONGEN was important in locating the peptide backbone" (column 16, lines 49-56). Further, using cluster analysis for determining the conformations induced in flexible peptides, 2 or more clusters were seen after minimization, and the remaining peptides were distributed as single-copies in higher energy positions (Example 5, column 18, lines 49-56). The disclosure cited above is consistent with the generally defined limitation of "the molecule may be higher than a lowest free energy estimate possible for the molecule."

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeLisi et al. (US 5,495,423 A) in view of In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983).

This rejection is maintained with respect to claims 1-4 as recited in the previous office action mailed May 12, 2003.

RESPONSE TO ARGUMENT

Applicant's argument that claim 1 recites that the selection of fragments and their orientation is predicated on a free energy estimate that "may be...for the molecule" has been fully considered and found to be not persuasive as discussed below. The argued limitation of free energy estimate that "may be...for the molecule" has been responded to above as directed to the disclosure of DeLisi et al. In regard the argument directed to the nonfunctional descriptive material", data directed to Src-homology-3 domain,...and human carbonic anhydrase II protein of claim 2 do not distinguish the invention from the prior art in terms of patentability because they are nonfunctional descriptive subject matter.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeLisi et al. (US 5,495,423 A) in view Hatada et al. (US 6251620 B1).

This rejection is maintained with respect to claims 1-4 as recited in the previous office action mailed May 12, 2003.

RESPONSE TO ARGUMENT

Applicant's argument is mainly directed to the deficiency of DeLisi et al. which has been responded to above.

Ardin H. Marschel 4/26/04
ARDIN H. MARSCHEL
PRIMARY EXAMINER